



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,303	05/01/2001	Yasushi Shimizu	N9450.0014/P014	3011

24998 7590 05/18/2005

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
2101 L Street, NW
Washington, DC 20037

EXAMINER

CHOI, LING SIU

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,303

Applicant(s)

SHIMIZU ET AL.

Examiner

Ling-Siu Choi

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-28 is/are pending in the application.
- 4a) Of the above claim(s) 8, 10, 12, 14, 16, 18, 20, 22, 24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Amendment filed February 7, 2005. Claims 1-6 were canceled and claims 7-28 have been added. Claims 7-28 are now pending, wherein claims 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, and 27-28 are drawn to a capillar array; claims 8, 10, 12, 14, 16, 18, 20, 22, 24, and 26 are drawn to a capillary array electrophoresis apparatus. Since claims 8, 10, 12, 14, 16, 18, 20, 22, 24, and 26 are patentably distinct from claims 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, and 27-28; and are presented after first Office Action, these claims will not be considered.

Claim Rejections - 35 USC § 112

2. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, and 27-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7, lines 2-3; claim 9, lines 2-3, the recitation "an electrophoresis medium injection port" cause indefiniteness. Is "electrophoresis medium" referred to "buffer solution" (page 9, lines 20-21) or polyacrylamide gel [Amendment (7 February 2005), page 8, line 8].

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, and 27-28 are rejected under 35 U.S.C. 35 U.S.C. 102(b) as being anticipated by Mathies et al. (US 5,274,240).

The present invention relates to a **capillary array** comprising

a plurality of capillaries	each being provided with a <i>sample injection port</i> and an <i>electrophoresis medium injection port</i> for injection of an electrophoresis medium
a voltage application portion	holding the <i>sample injection ports</i> spread from one another, provided with a plurality of electrodes to be immersed in a sample liquid together with the sample injection ports
a light detection portion	in which the capillaries are aligned substantially on a plane
an electrophoresis medium supply portion	which holds the <i>electrophoresis medium injection ports</i> in a bundle, in communication with an electrophoresis medium container

(summary of claim 1)

The rejection is adequately set forth in paragraph 2 of the previous Office Action and is incorporated herein by reference.

Response to the Applicants' Arguments

6. Applicants' arguments filed February 7, 2005 have been fully considered but they are not deemed to be persuasive.

Applicants: "The Office action relied on Mathies et al., U.S. Patent No. 5,274,240 (hereinafter "Mathies") to reject cancelled claims 1-6. Mathies discloses an electrophoresis apparatus using a plurality of capillaries, but no electrophoresis medium supply portion for permitting injection of electrophoresis medium is provided in the plurality of capillaries."

Firstly, "electrophoresis medium" is not understood because it may be referred to a "buffer solution" (page 9, lines 20-21) or polyacrylamide gel [Amendment (7 February 2005), page 8, line 8]. Secondly, since claim 1 claims "a plurality of capillaries, **each** being provided with a sample injection port and an **electrophoresis medium injection port**", it is substantial identical to the capillaries disclosed by Mathies et al.

Conclusion

Art Unit: 1713

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-1098.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114.

Application/Control Number: 09/845,303

Page 6

Art Unit: 1713

L. S. Choi

LING-SUI CHOI
PRIMARY EXAMINER

May 15, 2005